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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3692

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/880,558	Applicant(s) ASANO, TOMOYUKI	
	Examiner Nga B. Nguyen	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17,18 and 20-27 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 17,18 and 20-27 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on June 26, 2006, which paper has been placed of record in the file.
2. Claims 17, 18, and 20-27 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 17, 18, and 20-27 have been considered but are not persuasive.

In response to the applicant's arguments that Pitroda does not disclose "determining whether the service request and the digital signature are valid, and when it is determined that the service request and the digital signature are valid, collecting the fee from the user", examiner submits that see Pitroda column 14, lines 35-50, describing the status of the UET card during a sales transaction, at the point of sales terminal, the salesperson inputs transaction amount for a credit check and authorization, after proper verification at the main central computer, the authorization will appear on the display of the UET card and/or the point of sales computer, thus the central computer determines whether the transaction request or the service request is valid. Also, see column 17, lines 20-38, the salesperson determines whether the user's signature is valid by comparing the user's signature with the original digital signature store in the UET card, if the sales person is satisfied with the signature comparison, the sales person completes the transaction by transmitting the details transaction (the date of the transaction, the amount, the name of the retail store) to the credit provider.

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Therefore, *Pitroda does disclose "determining whether the service request and the digital signature are valid, and when it is determined that the service request and the digital signature are valid, collecting the fee from the user."*

4. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 17, 18, and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Pitroda, U.S. Patent No. 5,884,271.

Regarding to claim 17, Pitroda discloses a method for providing a fee for a service of a service provider comprising the steps of:

receiving a service request requesting desired service for a user from the service provider and a digital signature created based on said service request to said service provider (column 16, lines 1-25, generating an activation request to a service institution, the activation request include the user's electronic signature), wherein said service request and said digital signature are stored in a storage medium (column 16, 1-25, the activation request and the user's electronic signature are stored in the UET card);

determining whether said service request and said digital signature are valid and when it is determined that said service request and said digital signature are valid, collecting the fee from the user (column 14, lines 35-50, describing the status of the UET card during a sales transaction, at the point of sales terminal, the salesperson inputs transaction amount for a credit check and authorization, after proper verification at the main central computer, the authorization will appear on the display of the UET card and/or the point of sales computer, thus the central computer determines whether the transaction request or the service request is valid. Also, see column 17, lines 20-38, the salesperson determines whether the user's signature is valid by comparing the user's signature with the original digital signature store in the UET card, if the sales person is satisfied with the signature comparison, the sales person completes the

transaction by transmitting the details transaction (the date of the transaction, the amount, the name of the retail store) to the credit provider).

Regarding to claim 18, Pitroda further discloses wherein said storage medium is connectable to said user terminal, and the user sends said service request and said digital signature stored in said storage medium by submitting said storage medium (figure 2 and column 10, lines 25-50, the UET card connected to the POS computer 23 or to the home PC 24; column 10, lines 25-40, the POS computer 23 interfaces directly with the communication interface unit (CIU) to read/write information to and from the UET card and communicate with the main central computer of the credit card or bank card company).

Regarding to claim 20, Pitroda further discloses wherein said service request and digital signature stored in said storage medium are impossible for the user to rewrite (column 14, lines 1-18, the signature is stored in a memory location from which it can not be erased by the user).

Regarding to claim 21, Pitroda further discloses wherein said storage medium has information used for generating said digital signature (column 15, lines 40-47, the user writes his or her signature on the display in the space indicated and that signature is stored in semi-permanent memory of the UET cart).

Regarding to claims 22-23, Pitroda further discloses wherein said information includes the personal information of the user, discloses wherein said personal information includes a user name and a bank account number of user (column 2, lines

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45-60, the UET card is capable of storing personal information such as the card owner's name, address, date of birth, signature, credit card company account numbers, etc.).

Claims 24-25 are written in means and contain similar limitations found in claim 17-18 above, therefore, are rejected by the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda, U.S. Patent No. 5,884,271.

Regarding to claim 26, Pitroda discloses a system for requesting service of a service provider comprising:

a user terminal for providing to a service provider a service request requesting desired service and a digital signature created based on said service request to said service provider (figure 2, the CIU 21); and

a storage medium for storing said service request and said digital signature (figure 2, the UET card 20), and

an accounting terminal determines whether said service request and said digital signature are valid before collecting a fee from the user terminal (the POS 23).

Pitroda does not disclose wherein when the user objects to a charge, in response to a charge collection notice from an accounting terminal, the user enables a sending of a data stored in said storage medium to said accounting terminal. However, Pitroda discloses through the user of UET card, a substantial amount to such paperwork can be eliminated and transactions with the service companies can be conducted simultaneously in real time **to resolve disputes** and can be recorded electronically (column 18, lines 3-15), the UET card may be configured with sufficient memory to store all transactions electronically, so as to eliminate or reduce the need for paper receipts (column 11, lines 4-6), the UET card is capable of sending of a data stored in storage medium to the accounting terminal (column 10, lines 25-33). Moreover, it is well known in the art that when the user objects to a charge, the user often submits the transaction receipt to the accounting terminal. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Pitroda to enable the user sending of a data stored in said storage medium to said accounting terminal when the user objects to a charge, for the purpose of providing more convenient to the user when requesting a dispute transaction, because the user does not need to keep a paper copy of receipt which may be easily lost.

Regarding to claim 27, Pitroda discloses further wherein said storage medium is connectable to said user terminal, and the user sends said data stored in said storage medium by submitting said storage medium (figure 2 and column 10, lines 25-50, the UET card connected to the POS computer 23 or to the home PC 24; column 10, lines 25-40, the POS computer 23 interfaces directly with the communication interface unit

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(CIU) to read/write information to and from the UET card and communicate with the main central computer of the credit card or bank card company).

Conclusion

9. Claims 17, 18, and 20-27 are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:


(703) 872-9306 (for formal communication intended for entry),

or

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(571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany Street, Alexandria, VA, First Floor (Receptionist).


NGA NGUYEN
PRIMARY EXAMINER

September 15, 2006